

REMARKS

Claims 27 and 28 are canceled without prejudice, and therefore claims 26, 29, 30 and 34 are pending and being considered in the present application (since claims 16 to 25 and 31 to 33 were withdrawn in response to a restriction requirement).

Applicants thank the Examiner for considering the Information Disclosure Statement and indicating that all certified copies of the foreign priority documents have been received.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for indicating that claims 30 and 34 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claims 30 and 34 have been rewritten to include the features of their respective base claims 29 and 26. Claims 26 and 29 now include the features of claims 27 and 28, which have been canceled without prejudice. Accordingly, claims 30 and 34 are allowable. Claims 26 and 29 include certain features like those of claims 30 and 34 and they are therefore allowable for essentially the same reasons. It is therefore respectfully requested that the objections be withdrawn.

Claims 26 and 29 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 2003/0145328 A1 (“Rabinowitz”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claims 30 and 34 have been rewritten to include the features of their respective base claims 29 and 26. Claims 26 and 29 now include the features of claims 27 and 28, which have been canceled without prejudice. Accordingly, claims 30 and 34 are allowable. Claims 26 and 29, as presented, include certain features like those of claims 30 and 34 and they are therefore allowable for essentially the same reasons. It is therefore respectfully requested that the rejections be withdrawn.

In particular, as regards claims 26 and 29, these claims have been rewritten to include the features of claims 27 and 28, which are now canceled. It is believed that the applied reference does not identically disclose (or suggest) the combination of features of claims 27 and 28, as provided for in claims 26 and 29, as presented.

Accordingly, it is respectfully submitted that claims 26 and 29, as presented, are allowable.

Withdrawal of the anticipation rejections is therefore respectfully requested.

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rabinowitz in view of Kilpatrick, U.S. Patent No. 5,898,402

Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rabinowitz in view of Kilpatrick, U.S. Patent No. 5,898,402, in view of U.S. Patent No. 4,531,232 to Sakurai.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 27 and 28 are canceled without prejudice, since their combination of features have been included in claims 26 and 29. It is believed and respectfully submitted the combination of the features of claims 27 and 28, as provided for in claims 26 and 29, are not disclosed by the references as applied. In any even, the rejections of claims 27 and 28 are moot, since they are canceled without prejudice.

Withdrawal of the obviousness rejections of the claims is therefore respectfully requested.

In sum, claims 26, 29, 30 and 34 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending and considered claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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